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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/913,430	12/09/1997	JOHN WALKER	U011415-0	6829

7590 04/07/2004  
LADAS & PARRY  
26 WEST 61ST STREET  
NEW YORK, NY 10023

EXAMINER

SWARTZ, RODNEY P

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/913,430

Applicant(s)

WALKER ET AL.

Examiner

Rodney P. Swartz, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29December2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 53-59,67,70-72 and 75-98 is/are pending in the application.
- 4a) Of the above claim(s) 53-59,67,70-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 75-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 53-59,67,70-72 and 75-98 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicants' Request for vacating the Final Office Action, mailed 12March2003, is acknowledged and hereby vacated.

### **Continued Prosecution Application**

2. Applicants' response to the Notice to File Missing Parts, mailed 9October2003. The fees have been paid. Therefore, the request filed on 6May2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/913,430 is acceptable and a CPA has been established. An action on the CPA follows.
3. New claims 95-98 have been added. Claims 53-59, 67, 70-72, and 75-98 are pending. Claims 53-59, 67, and 70-72 are withdrawn from further consideration by the examiner 37 C.F.R. 1.142(b), as being drawn to a nonelected invention (Office Action, 24November1999, paper#17).
4. Claims 75-98 are under consideration.

### **Rejections Maintained**

5. The rejection of claims 93 and 94 under 35 U.S.C. 112, second paragraph, as being indefinite for "functional equivalent thereof" is maintained.

Applicants argue that it is clear that the term relates to the respective amino acid sequences encoded by SEQ ID NO:1 and defined by SEQ ID NO:2 and not to other sequences.

The examiner has considered applicants' argument, but does not find it persuasive. While the amendment of the claims does remove some of the indefiniteness of the original term, there remains indefiniteness for what are the functions to which the claimed sequence is "equivalent", e.g., just immunogenicity, chemical equivalency, etc.

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6. The rejection of claims 75, 76, 84, 85, and 89-92 under 35 U.S.C. 102(b) as being anticipated by Faulds et al (U.S. Pat. No. 5,252,328) is maintained.

Applicants argue that the sera utilized by Faulds et al were obtained from convalescent pigs and therefore the antigens identified are thus clearly different from the claimed antigens. Applicants argue that "a short time" would be understood by one of skill in the art to exclude the type of antibodies utilized by Faulds et al.

The examiner has considered applicants' arguments, but does not find them persuasive. The term "a short time" is not defined by the claim nor the specification and therefore does encompass the samples of Faulds et al. Likewise, the antigens taught by Faulds meet the criteria of the instant claims.

7. The rejection of claims 75-94 under 35 U.S.C. 102(e) as being anticipated by Bredt et al (U.S. Pat. No. 5,641,638) is maintained.

Applicants argue that the antigen(s) of Bredt et al are clearly larger than the claimed antigens.

The examiner has considered applicants' argument, but does not find it persuasive for the reasons put forth in the original rejection. One of the embodiments of the instant claims is drawn to an antigen with a molecular structure which is a mutant or a derivative of the native antigen. Without a definition of what constitutes "a derivative", the antigens of Bredt et al fulfill this criticality, i.e., they are also *Mycoplasma* antigens.

#### **New Rejections Necessitated by Amendment**

#### **Claim Rejections - 35 USC § 112**

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

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enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 95-98 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims depend from rejected claims.

### **Conclusion**

11. No claims are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (571)272-0864.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

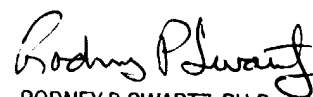
13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RODNEY P. SWARTZ, PH.D.

PRIMARY EXAMINER

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April 5, 2004